

**Notice of Allowability**

Application No.

10/032,361

Examiner

Samuel W. Liu

Applicant(s)

MCGRATH, KEVIN

Art Unit

1653

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11/7/05.
2. ☒ The allowed claim(s) is/are 2,25 and 27-29.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 12-05-05 12-09-05.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

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### **DETAILED ACTION**

The amendments filed 11/7/05 which amends claims cancels claims 1, 3-24 and 50-52, and amends claims 25-26 have been entered. The following Office action is applied to the pending claims 2 and 25-49.

### **EXAMINER'S AMENDMENT**

An Examiner's Amendment to the record appears below. Should the change and/or additions be unacceptable to Applicant, an amendment may be filed as provided by 37 C.F.R. § 1.312. To ensure consideration of such an amendment, it MUST be submitted no latter than payment of the Issue Fee.

Authorization for this Examiner's Amendment was given in an interview with Applicants' representative Robin A. Chadwick on December 5, 2005. Applicant agrees to cancel claims 26 and 30-49 without prejudice (see below).

#### **Amendments to the claims:**

The pending claims 26-49 have been amended as follows. Please replace the previous claims with the claims shown below.

Delete Claim 26.

Claim 27 (*Amended*): The pharmaceutical formulation of claim 25 ~~or 26~~ that is administered in conjunction with a wound dressing.

Claim 28 (*Amended*): The pharmaceutical formulation of claim 25 ~~or 26~~ that is a sustained release formulation.

Claim 29 (*Amended*): The pharmaceutical formulation of claim 25 ~~or 26~~ that is administered in conjunction with a surgical implant.

Delete Claims 30-49

*Conclusion:* Claims 2, 25 and 27-29 are allowed.

The following is an **Examiner's Statement of Reasons for Allowance**: The prior art of record does not teach or suggest the disclosed glycopeptide as set forth in claim 7 and the method of treating a bacterial disease comprising administering to a subject the said glycopeptide.

(1) In accordance with the telephonic interview with Applicants' representative (see the Interview Summary), applicants agree that SEQ ID NO:47 should be changed to SEQ ID NO:7. Given this, claims 25 and 26 are objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Applicants therefore agree to cancel claim 26.

(2) The process claims 30-49 as written are drawn into use of the peptide having formula I or II set forth in instant claims 30 and 40 (independent claims), wherein the formula I (or II) peptide has different (broader) scope than the claimed peptide of SEQ ID NO:7. Here, proper restriction requirement between product claims and process claims is maintained. Withdrawn process claims (see the Office action mailed 9/3/04) that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996).

(3) On Example section (pages 25-27), the specification sets forth utility of the SEQ ID NO:7 peptide has ability of regulating angiogenesis which involves in therapeutic application, and US Pat. No. 6849718 has disclosed the pharmaceutical compositions containing hypoxia inducible factor alpha (abstract). Thus, "pharmaceutical formulation comprising SEQ ID NO:7 peptide" is considered patentable.

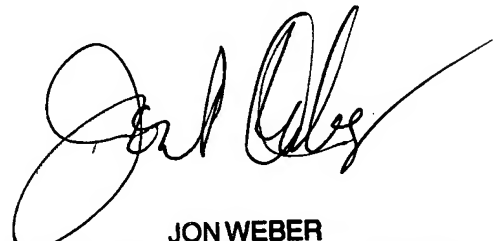
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Any comments considered necessary by applicants must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Samuel Wei Liu, Ph.D. whose telephone number is (571) 272-0949. The Examiner can normally be reached daily except alternate Fridays from 8:30 A.M. to 5:30 P.M. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Jon Weber, can be reached at (571) 272-0925. The official fax number for Technology Center 1600 is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.



Samuel W. Liu, Ph.D.  
Art Unit 1653, Examiner  
December 5, 2004



**JON WEBER**  
**SUPERVISORY PATENT EXAMINER**